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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Robert Martin Wynalda JR.

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

01/21/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/883,619	WYNALDA ET AL.	
	Examiner	Art Unit	
	ALICIA CHEVALIER	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-15, 23, 27, 28, 30-32 and 34-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-15, 23, 27, 28, 30-32 and 34-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)
2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____. | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) <input type="checkbox"/> Notice of Informal Patent Application
6) <input type="checkbox"/> Other: _____. |
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RESPONSE TO AMENDMENT

1. Claims 7-15, 23, 27, 28, 30-32 and 34-39 are pending in the application, claims 1-6, 16-22, 24-26, 29 and 33 have been cancelled.
2. Amendments to the claims, filed on September 30, 2008, have been entered in the above-identified application.

REJECTIONS

3. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 103

4. Claims 7-15, 23, 27, 28, 30-32 and 34-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weisburn et al. (U.S. Patent No. 5,697,498) in view of Eskandry (U.S. Patent No. 6,409,013).

Weisburn discloses a CD or DVD storage container for holding media multiple discs (*title and figure 2*) and for providing multiple locations for printed graphics (*col. 7, lines 17-19*). The storage container comprising a cover having a front cover member, a rear cover member, and a spine disposed between the front and rear cover members (*figure 2*). The container further comprises at least one page having a structure adapted to hold at least one item of recorded media, the page having a first and second side surfaces and is deemed to be adapted to hold at least one item or recorded media disposed on one of the first and second sides of the page (*figure*

2). The at least one page having at least one edge and the front and rear cover members being moveable between open and closed positions (*figure 2*). Each page being adapted to hold two items of recorded media and each page including being formed from two page halves that are connected together in a back to back arrangement so that two discs are accessible from opposite sides of each page and each page being substantially rigid (*figure 2*). The edge of the page cooperates with the spine to define a pocket that is V-shaped in cross section to provide a pocket, the V-shaped pocket with an apex disposed directly between the first and second sides of the page (*figures 7-9*).

Weisburn fails to disclose the edge of the page being connected to the spine with an adhesive to connect the page to the cover and the cover being fabricated from paperboard.

Eskandry discloses a compact disk case (*title*) comprising a cover made plastic or cardboard, i.e. paperboard, (*col. 11, lines 9-22*) and the means for mounting the pages to the spine includes adhesive bonding the plate hinge segment to the spine (*col. 3, lines 6-15 and col. 11, lines 25-29*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to adhesively bond the pages of Weisburn to the spine as taught by Eskandry in order to reduce cost and processing steps. Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use paperboard for the cover in Weisburn as taught by Eskandry, since it is obvious to use equivalent materials for the same intended use. MPEP 2144.07.

Weisburn further discloses that the page halves are connected together with locking fingers (*latching tabs, col. 6, line 12*). The page halves define a pocket associated with each

locking finger and each locking finger is disposed in one of the pockets to protect the locking finger (*figures 5 and 5a*). The container further comprises a literature card disposed between the page halves (*col. 7, lines 17-19*). Each page half includes a rear surface with a planar portions that abut the literature card (*figures 5 and 5a*). The page halves are substantially transparent (*col. 7, lines 17-19*). Each page half includes a planar portion surrounding the disc holding hub (*figures 5 and 5a*). The front and rear covers pivot with respect to the outer spine (*figures 1 and 2*).

The limitation “the page halves are connected together with a weld” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

ANSWERS TO APPLICANT'S ARGUMENTS

5. Applicant's arguments in the response filed September 30, 2008 regarding the 35 U.S.C. 103(a) rejection over Weisburn et al. (U.S. Patent No. 5,697,498) in view of Eskandry of record have been carefully considered but are deemed unpersuasive.

Applicant argues that the page edges of Weisburn do not define the V-shaped pocket recited in pending claim 7. Applicant further argues that page edges are flat as shown in figure 9.

Applicant's claim 7 recites "the edge of the page defining a pocket that is V-shaped in cross section to provide a pocket for the adhesive." The end edge of each page in Weisburn as shown in figure 9 includes two angled portions and a flat portion. When two pages are next to each other as shown in figure 9 the angled portions create a pocket that is V-shaped in cross section. The fact that Weisburn includes additional structure not required by Applicant's invention, e.g. the flat portion of the end of each page, is irrelevant.

Applicant argues that bonding the Weisburn pages to a cover in the manner recited in the office action would destroy the function of the Weisburn hinges and prevent the ends of the sidewalls from camming against one another.

The examiner respectfully disagrees. Eskandry also discloses a hinge function and the addition of the adhesive does not destroy the ability of the hinge to function (*Eskandry, col. 3, lines 6-15 and col. 11, lines 23-29*). Therefore, since Eskandry teaches that hinges and adhesives can be used together, one of ordinary skill in the art would have been motivated to use an adhesive with the hinges in Weisburn.

Applicant further argues that the office action concludes that one of ordinary skill in the art would make this change to Weisburn to "reduce costs and processing steps" without explanation of how these reductions would occur or if the purported changes to Weisburn would even result in such reductions.

It would have been obvious to one of ordinary skill in the art at the time of the invention to adhesively bond the pages of Weisburn to the spine as taught by Eskandry in order to reduce cost and processing steps. One of ordinary skill in the art would have been motivated to use adhesive as the mounting because it is less costly and requires less processing steps than other

mounting means such as bolts and rivets. Furthermore, the addition of adhesive to Weisburn would insure mounted pages were secured in the carrying case.

Applicant argues that changing the Weisburn cover to a different material, as suggested in the office action, does not yield the device of claim 7 because Weisburn does not disclose the other structural limitations of claim 7 as described above.

Applicant's arguments regarding the other structural limitations of claim 7 have already been addressed above.

Applicant argues that claim 27 defines that relationship of the literature page and the page halves and requires the literature page to be pressed between the page halves. Applicant further states that Weisburn pages define a literature page compartment that allows the literature to be slipped into and out of the compartment and thus is not pressed.

Applicant has not clearly point out what structural difference between the instant claimed invention and Weisburn. Claim 27 recites that "a literature card being pressed between the first and second halves such that the literature card is disposed between the disc-shaped items of records media when the disc-shaped items of recorded media are carried by the page halves." The only requirement of the method limitation "pressed" is that the literature care is between the page halves. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. The fact the Weisburn's literature card is removable does not alter the fact that the literature is disposed between the disc-shaped items of records media when the disc-shaped items of recorded media are carried by the page halves.

Applicant further argues that Weisburn does not teach all the limitations of claims 27, 30 and 35 also requires the page of the container to have at least one edge connected to the inner surface of the outer spine with an adhesive to connect the page to the cover.

In response to Applicant's arguments, 37 CFR 1.111 (c) requires application to "clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections." In this case, Applicant had failed to clearly point out patentable novelty and failed to show how the amendment avoids the combination of references applied against the claim. Furthermore, the adhesive issue has been addressed above. Furthermore, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues the combination of Weisburn and Eskandry. However, these arguments have already been addressed above.

Applicant argues that claim 11 is not a method claim and a weld is a structural element that connects the two page halves.

The definite of weld is "to unite or reunite closely or intimately" or "capable of being welded." Applicant has disclosed the weld type or the structural difference between the prior art and the instant claimed invention. Furthermore, Applicant's specification how the pages are welded or what type of weld is used.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Alicia Chevalier/

Primary Examiner, Art Unit 1794

1/21/2009